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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09 17 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 5/8/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14 and 16-21 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-14 and 16-21 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 1
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

### **DETAILED ACTION**

This Office action is in response to the amendment filed May 8, 2002 in which claims 1, and 10-15, were amended, claim 16 was canceled, claims 9 and 20 were added and claims 17-20 were renumbered.

The examiner recommends that all claims be canceled and a new set of claims be presented for examination. The new claims should begin with claim 22. It should be noted that at no time during prosecution should applicant renumber the claims. The renumbering of claims is only done at the time of allowance and by the examiner. It should also be noted that when a claim is not present, as in the instant case (claim 9), the claims will be renumbered by the office according to 37 CFR 1.126.

The claims currently present in the specification are claims 1-14, and 16-21. Claims 10-20 have been renumbered as claims 9-19 with 15 being canceled. Added claim 9 is now claim 20 and new claim 20 is now claim 21.

### ***Specification***

1. The amendment filed May 8, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the subject matter of page 6 which reads "about 22%"; "about 40% and "about 70%. The term "about" broadens the scope of the invention.

***Claim Rejections - 35 USC § 112***

Applicant is required to cancel the new matter in the reply to this Office Action

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 10, 11, 13, 14 (original claims) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original filed specification does not support about 2% to about 35% (col. 10); about 22% (claim 11); about 40% (claim 13); about 70% and "in combination with other components" (claim 1). These limitations broaden the scope of the invention.

Claims 1-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tao (US 6,284,007).

Tao teaches a vegetable lipid-based composition and candle comprising fully hydrogenated triglycerides and free fatty acids (see col. 1, lines 60-67). The triglycerides and free fatty acids are obtained from plant sources (see col. 2, lines 51-55) and are preferably saturated (see col. 3, lines 1-2). The free fatty acid/triglyceride mixture contains from 1-99% triglyceride and from 1 to 99% free fatty acid (see Example 5). Tao teaches the limitations of the claims other than the difference that is discussed below.

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Tao differs from the claims in that he does not specifically teach the claimed iodine value. However, it would be reasonable to expect that the triglycerides and fatty acids of Tao would possess the claimed iodine value because Tao teaches that the triglycerides are fully hydrogenated and that he prefers triglycerides and free fatty acids that are saturated.

Applicant argues that the examiner has not established a prima facie case of obviousness because the examiner stated that it would be reasonable to expect that the triglycerides and fatty acids of Tao would possess the claimed iodine value.

3. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that the examiner has not established a prima facie case of obviousness because the examiner stated that it would be reasonable to expect that the triglycerides and fatty acids of Tao would possess the claimed iodine value.

It is well settled that obviousness requires only a reasonable expectation of success. Applicant has provided no evidence showing that Tao's triglycerides and fatty acids do not possess the claimed iodine value.

Applicant argues that Tao teaches away from the present invention because he states that the fatty acids and triglycerides may be unsaturated.

It should be noted that Tao also states that "the free fatty acids and fatty acid components of the triglycerides are "preferably" saturated ...". Thus, Tao clearly prefers saturated low iodine value components.

Applicant argues that Tao only hydrogenates in order to produce solid candles and that Tao did not recognize that by use of low iodine value fatty acid components that a substantially soot-free candle could be achieved.

Tao teaches that his components are plant derived; he teaches that the triglycerides are hydrogenated and that they may be fully hydrogenated. This teaching suggests low iodine value triglycerides. Tao also teaches that his candle "minimizes the risk to human health upon burnings" (col. 1, lines 24-30, 43-48). This suggests that he is concerned about producing a substantially soot-free candle.

4. The 103 rejection of the claims over will is withdrawn in view of Applicant's arguments.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 11, 16-19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Calzada (US 6,063,144).

Calzada teaches a non-paraffin candle composition comprising plant source stearic acid and hydrogenated vegetable wax (hydrogenated castor oil) (see col. 2, lines 9-28; col. 3, lines 12-15). Calzada desires a stearic acid and vegetable wax that have a iodine number no greater than 7 (see col. 2, lines 51-53; col. 3, lines 9-12).

Accordingly, Calzada teaching all material limitations of the claims, anticipates the claims.

6. Applicant argues that Calzada allows for vegetable oils having IV of up to 150.

Calzada teaches that the vegetable oil is an optional ingredient. Therefore, in the absence of the vegetable oil the candle of Calzada would possess the claimed IV and would produce less soot upon burning.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 63168494.

JP teaches a composition of hydrogenated palm stearin and optionally beef tallow having a IV of 1-5. JP teaches that these products are suitable for use in preparing candles (see abstract in its entirety).

Accordingly, JP teaching all the material limitations of the claims, anticipates the claims.

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Applicant argues that JP does not enable one to produce a low-soot or no-soot candle because JP teaches that hydrogenated palm stearin may be used to produce a candle.

The examiner respectfully disagrees. Applicant teaches that his candle contains hydrogenated plant source triglyceride and other components having an IV of less than 10 to less than 1. JP teaches that hydrogenated palm stearin and beef tallow having an IV of 1-5 may be prepared into a candle. Applicant's claims do not contain the additional components that Applicant states that JP does not contain, i.e. a wick, wax component, color, etc.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63168494.

JP has been discussed above. JP fails to teach that the hydrogenated palm stearin has an IV of less than 1. However, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals v. Banner*, 227 USPQ 773 (Fed. Cir. 1985).

Applicant's arguments are similar to those above regarding JP. Therefore, the examiner will not repeat her response. JP teaches a candle composition similar to that of Applicant and the skilled artisan would expect the candle compositions to have similar properties.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States



Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Phadoemchit (US 4,842,648).

Phadoemchit teaches candles comprising palm stearin and glyceryl monostearate wherein the composition has an IV of 0 to 5 (see col. 1, lines 5-11; col. 2, lines 15-23; col. 2, lines 64-68; col. 3, lines 1-32).


Accordingly, Phadoemchit teaching all the material limitation of the claims, anticipates the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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September 16, 2002